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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/749,050

12/27/2000

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10191/1642

5508

26646 7590 01/29/2009

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EXAMINER

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ART UNIT

PAPER NUMBER

2432

MAIL DATE

DELIVERY MODE

01/29/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IMMANUEL KRAUTER, CLAUS MOESSNER,
and AXEL AUE

Appeal 2008-2735
Application 09/749,050
Technology Center 2100

Decided: January 29, 2009

Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and
THU ANN DANG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates to detecting manipulation of a programmable memory device of a digital controller for a motor vehicle, where data and control programs for operation of the controller and for control/regulation of certain functions of the motor vehicle can be stored in the memory device. (Spec. 1, ll. 1-5).

Independent claim 1 is illustrative:

1. A method for detecting a manipulation of a programmable memory device of a digital controller for a motor vehicle, comprising the steps of

storing in the programmable memory device data and control programs for an operation of the digital controller and for a control/regulation of functions of the motor vehicle;

storing information regarding a programming/reprogramming operation in a separate memory area of the programmable memory device where only reading and programming are possible, the step of storing information regarding the programming/reprogramming operation being performed in conjunction with each programming/reprogramming operation of the programmable memory device, the stored information recording a number of times the programmable memory device has been programmed/reprogrammed; and

reading out and comparing a content of the separate memory area with another set of information in order to detect a manipulation, wherein the separate memory area is incapable of being erased, and wherein a remaining memory area of the programmable memory device is capable of being erased.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the obviousness rejections:

Berra	US 5,787,367	Jul. 28, 1998 (filed Jul. 3, 1996)
Blomquist	US 5,658,250	Aug. 19, 1997 (filed Nov. 8, 1995)
Komori	US 6,044,014	Mar. 28, 2000 (filed Jun. 16, 1999)

THE REJECTIONS¹

1. The Examiner rejected claims 1-7 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Berra, in view of Komori and Blomquist.
2. The Examiner rejected claim 8 under 35 U.S.C. § 103(a), as being unpatentable over Berra in view of Komori.

“[T]he examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

¹ The Final Office Action included a rejection of claims 1-7 and 9 under 35 U.S.C. § 112 second paragraph. The Examiner withdrew the rejection in the Examiner’s Answer. (Ans. 2). Therefore, the rejection under 35 U.S.C. § 112 is not before us.

Obviousness under 35 U.S.C. § 103

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Claims 1-7 and 9-11

We consider the Examiner’s rejection of claims 1-7 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Berra in view of Komori and Blomquist. Since Appellants’ arguments have treated these claims as a single group which stand or fall together, we select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants’ Contentions

1. Appellants contend that the cited references, most notably Blomquist, fail to teach or suggest the limitation of a *separate memory area is incapable of being erased*, and that the *remaining memory area of the programmable memory device is capable of being erased*. (App. Br. 10)

2. Appellants contend that the flash memory 150 disclosed in Blomquist is not analogous to the “separate memory area” recited in claims 1 and 9. (*Id.* at pp. 10-11)
3. Appellants contend that Blomquist does not disclose a memory area that is incapable of being erased. (Reply Br. 4)

ISSUE

Have Appellants shown the Examiner erred in determining that the cited references teach the claimed limitation of the “separate memory area is incapable of being erased?”

FINDINGS OF FACTS

The following Findings of Facts (FF) are supported by a preponderance of the evidence.

Blomquist

1. The Examiner relied on Blomquist to teach the limitation of the separate memory area that is incapable of being erased. (See Ans. 5).
2. Blomquist teaches flash memory 150 that includes a boot program which is preferably non-erasable. (Col. 8, ll. 23-24).
3. Blomquist teaches a flash memory (“Intel product”) that includes separately erasable and reprogrammable blocks of memory, at least one of which can be blocked from erasure, once programmed with the desired information. (Col. 8, ll. 53-56).

Specification

4. The Specification teaches that the one-time programmable memory region of a programmable memory device is implemented with *flash memory*. The flash cells of the OTP region have only lines for programming or reading the content of the flash cells. (Spec. 5, ll. 12-17) (emphasis added)

ANALYSIS

As mentioned above, Appellants contend that the cited references fail to teach or suggest the limitations of a *separate memory area that is incapable of being erased*, and that *the remaining memory area of the programmable memory device is capable of being erased*.

As discussed above, we find that Blomquist discloses an Intel product that includes reprogrammable blocks of memory, *at least one of which* (separate area) *can be blocked from erasure once programmed with the desired information* (incapable of being erased). (FF 3) (emphasis added). The Intel product disclosed in Blomquist is consistent with the OTP memory described in Appellants' Specification, and referenced in Appellants' arguments. (FF. 4 and App. Br. 10-11). For this reason, we do not find the Appellants' arguments to be persuasive.

We conclude that Appellants have not shown error in the Examiner's *prima facie* case rejecting claim 1. Accordingly, we sustain the Examiner's rejection under 35 U.S.C. § 103(a) of claim 1, and claims 2-7 and 9-11 which fall therewith, as being unpatentable over Berra in view of Komori and Blomquist.

Claim 8

We next consider the Examiner's rejection of claim 8 as being unpatentable over Berra in view of Komori.

Claim Construction

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

At the outset, we note that claim 8 recites a "separate memory area of the programmable memory device where only reading and programming are possible." Claim 8 is otherwise silent with regards to the separate memory area being incapable of being erased. We decline to read any such limitation into claim 8.²

We further note that the limitation argued by Appellants is expressly recited in independent claims 1 and 9. Thus, Appellants' argument that the limitation is "plain to anyone" is not persuasive. (See Reply Br. 6)

Appellants' arguments are based upon the assertion that the references fail to teach a separate memory area that "is not capable of being erased." However, as discussed above, this limitation is not expressly recited in claim

² "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, (Fed. Cir. 2004).

8, and we will not read this limitation into the claim. In particular, we note that programming a device necessarily involves overwriting, i.e., erasing the previous memory contents in order to add the new program.

It is our reasoned view that Appellants are arguing limitations that are not recited in claim 8. Thus, based on the record before us, we conclude that Appellants have not met their burden of showing error in the Examiner's *prima facie* case.

REPLY BRIEF

We note that the Reply Brief is properly used to respond to points of argument raised by the Examiner in the Answer and not as a means for presenting new arguments. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). While we have fully considered Appellants' responses in the Reply Brief, we decline to address any new arguments not originally presented in the principal Brief. With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Based on the record before us we conclude that Appellants did not show error in the Examiner's *prima facie* case of obviousness. Accordingly, we sustain the Examiner's rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over Berra in view of Komori.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

Appellants have not shown that the Examiner erred in determining that the cited references teach the claimed limitation of “separate memory area is incapable of being erased.”

Therefore, claims 1-11 are not patentable.

DECISION

The decision of the Examiner rejecting claims 1-7 and 9-11 under 35 U.S.C. § 103(a) is affirmed.

The decision of the Examiner rejecting claim 8 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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